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HML-201-A-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: M. Lowenstein
Serial Number: 08/422,360
Filed: 17 April 1995
Group Art Unit: 2104
Examiner: S. Medley
Title: ELECTRICAL FILTER/PROTECTOR, AND
METHODS OF CONSTRUCTING AND UTILIZING
SAME

REPLY BRIEF ON APPEAL UNDER 37 CFR §1.193

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

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BOARD OF PATENT APPEALS
AND INTERFERENCES

In accordance with the provisions of 37 CFR §1.193(b), please enter the following Reply Brief in response to the Examiner's Answer dated 9 December 1996, in the above-identified application.

New Points of Argument in Examiner's Answer

1. The Examiner contends that it would have been obvious to an ordinary artisan to modify some acknowledged known devices and the Stacey device (U.S. Patent No. 3,849,677) with a passive resistor in parallel with a passive capacitor and reactor as taught by Thanawala (U.S. Patent No. 3,881,137), since "doing so would provide a third order harmonic filter in a simpler arrangement." (Examiner's Answer, page 5).

2. The Examiner takes official notice that current sensing and current limiting is well known; and takes official notice that it would have been obvious to modify Stacey to include a current sensing and current limiting circuit. (Examiner's Answer, pages 5 and 6).

3. The Examiner states that it would have been obvious to mount a filter into "any rack" or similar structure since no change in the functionality of a filter would occur. (Examiner's Answer, pages 5 and 6).

4. The Examiner states that since Gilardi allegedly discloses a transformer, arguments contending that no cited reference discloses an equipment rack panel member are moot. (Examiner's Answer, page 8).

5. The Examiner states that placing a filter in any type of housing is obvious since doing so "is a mere intended use for the invention." (Examiner's Answer, page 8).

APPELLANT'S RESPONSE TO THE EXAMINER'S NEW POINTS OF ARGUMENTS

1. Regarding the Examiner's contention that it would have been obvious to an ordinary artisan to modify some acknowledged known devices and the Stacey device with a passive resistor in parallel with a passive capacitor and reactor as taught by Thanawala, since so doing would result in a simpler arrangement, appellant respectfully points out that simplicity does not negative patentability. *In re Oetiker*, 24 USPQ.2d 1443 (Fed. Cir. 1992). Even so, and forgetting for the sake of argument the Examiner impermissibly ignoring supply frequency resonant circuitry L_D/C_D and other circuitry which is essential to the teaching of Thanawala, appellant respectfully submits that the Thanawala inductor L_P is used for damping at frequencies lower than the supply frequency, not at harmonic frequencies. It remains to be seen how the Examiner can utilize Thanawala inductor L_P in this way to produce the claimed invention.

2. Appellant respectfully submits that the Examiner is not permitted to take official notice that a claimed invention is obvious. Such is not the type of information on which an Examiner may take official notice. MPEP §2144.03. Even so, appellant respectfully submits that no teaching relied upon by the Examiner discloses the combination of a current sensing circuit and a current limiting circuit as recited in the pending claims. The claimed invention provides a significant advantage over other devices in part because the claimed invention treats virtually all current concerns related to conventional electrical systems in a single component. In an absence of any such teaching, appellant respectfully submits that the Examiner has failed to establish prima facie obviousness of the claimed invention.

3. The Examiner's contention that a claim reciting a filter with any equipment rack panel member is unpatentable because such a claimed invention does not change the functionality of the filter. Appellant respectfully submits that such conclusory finding wholly

ignores the test for obviousness as set forth by the U.S. Supreme Court in *Graham v. John Deere Co. of Kansas City et al.*, 148 USPQ 459, which requires that

the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved.

Graham, 148 USPQ at 467. By failing to apply the *Graham* test for determining obviousness and instead relying upon logic which is not supported by any court case, patent statute or patent rule, and because no reference relied upon by the Examiner even remotely mentions an equipment rack panel member much less one as recited in the claims, appellant respectfully submits that the Examiner has impermissibly relied upon hindsight in rejecting claims 12-15 and 17-19.

4. The Examiner contends that since Gilardi allegedly discloses an isolation transformer, any arguments which assert that Gilardi fails to disclose a system having an equipment rack panel member or other features recited in claims 12-15 and 17-19 are moot. Appellant respectfully submits that an examiner must consider all elements recited in a claim in determining the patentability of the invention claimed. *In re Lowry*, 32 USPQ.2d 1031 (Fed. Cir. 1994). In this case, the Examiner has failed to consider all of the recited elements in rejecting claims 12-15 and 17-19. As a result, appellant respectfully submits that the Examiner has failed to establish prima facie obviousness of the invention claimed in claims 12-15 and 17-19.

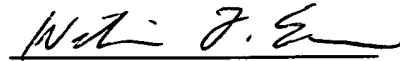
5. The Examiner states that placing a filter in any type of housing is obvious since doing so is a mere intended use for the invention. Appellant respectfully submits that the claims in question do not use "intended use" language. Rather, each claim positively recites a filter and a housing. Appellant respectfully points out that the test for obviousness is clearly set forth in *Graham* and its progeny. By failing to apply the proper test for obviousness and by failing to show any prior teaching of systems having housings or other features as claimed in the present invention, appellant respectfully submits that the Examiner has failed to establish prima facie obviousness for claims 12-15 and 17-19.

Appellant encloses herewith copies of the Reply Brief in triplicate.

Favorable reconsideration and reversal of the final rejections are respectfully

requested.

Respectfully submitted,



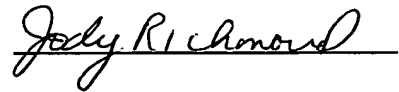
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March 10, 1997

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to Commissioner of Patents and Trademarks, Washington, D.C. 20231 on March 10, 1997.

Dated: March 10, 1997



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